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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,499	01/12/2004	Noboru Tatsuki	0050-0155CON1	1989
44987	7590	02/06/2008		
HARRITY SNYDER, LLP 11350 Random Hills Road SUITE 600 FAIRFAX, VA 22030			EXAMINER PHUNKULH, BOB A	
			ART UNIT 2619	PAPER NUMBER
			MAIL DATE 02/06/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/755,499

Applicant(s)

TATSUKI, NOBORU

Examiner

Bob A. Phunkulh

Art Unit

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 15 and 22-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 15, 22-31, 35-43 and 45 is/are rejected.
- 7) ☒ Claim(s) 32-34 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/333,608.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to because letterings are small and are not readable (figure 2). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14 and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,731,651. Although the conflicting claims are not identical, they are not patentably distinct from each other because elimination of an element and its function provides no patentable difference. Claims 14 and 22 are encompassed by claim 1 of U.S. Patent No. 6,731,651. It is well settled that elimination of elements and their function is considered to be obvious to one of ordinary skill in the art. *In re Karlson*, 153 USPQ 184 (CCPA 1963).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14-15, 31-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 14, 36, it is not clear what it meant by "de-multiplexing the received cell into a signaling cell and a voice cell" as cited the claims. There is no need for de-multiplex the cell since only one cell is received.

Regarding claims 31 and 45, the claimed subject matter "operate cell to produce a first signaling cell and a first voice cell" is vague and indefinite since it is not clear how a cell can produce signaling cell and voice cell.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-15, 22-31, 35-43 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by *KAGEMOTO* (US 5,623,493).

Regarding claim 14, *KAGEMOTO* discloses a voice relaying method comprising: receiving a cell (the demultiplexer 31 receives incoming cells, see figure 1); and de-multiplexing the received cell into a signaling cell and a voice cell; disassembling the voice cell into a voice signal and disassembling the signaling cell into a first signaling signal (demultiplexer 31 receives incoming cells, see figure 1); detecting whether a relay switch operation is being carried out (col. 10 line 65 to col. 11 line 30);

assembling the voice signal into a voice cell, and producing a signaling cell based on the first signaling signal (see col. 10 line 65 to col. 11 line 30); and

transmitting, to a cell produced by multiplexing the signaling cell and the voice cell which are assembled during the assembling (multiplexing the cells by multiplexer 39, see figure 1);

wherein the disassembling includes adding an identification signal to the voice signal to produce a first voice signal and sending the first voice signal to a switch (see col. 10 lines 65 to col. 11 line 30); and

wherein, the detecting includes detecting that the relay switch operation is being carried out when the first voice signal is received from the switch (see col. 10 lines 65 to col. 11 line 30).

Regarding claim 15, *KAGEMOTO* discloses wherein the identification signal is composed of a synchronous signal (see col. 10 lines 65 to col. 11 line 30).

Regarding claim 22, *KAGEMOTO* discloses a network device, comprising:
a receiver section to receive an incoming cell (see col. 11 line 40 to col. 12 line 5);

a disassembler section to produce a voice signal from the incoming cell (a demultiplexer, see col. 11 line 40 to col. 12 line 5);

a detection section to determine if an operation is being performed on behalf of the incoming cell (see col. 11 line 40 to col. 12 line 5);

an assembler section to produce a cell that includes the voice signal if the operation is being performed (the multiplexer, see col. 11 line 40 to col. 12 line 5); and
an identification section to add an identification signal to the produced cell before making the produced cell available to a network (see col. 11 line 40 to col. 12 line 5).

Regarding claim 23, *KAGEMOTO* discloses a transmission section to make the produced cell available to the network (the multiplexer transmits the cells to the network, see figures 1 and 2).

Regarding claim 24, *KAGEMOTO* a transmission section to send the produced cell to a destination via the network (the multiplexer transmits the cells to the network, see figures 1 and 2).

Regarding claim 25, *KAGEMOTO* discloses the destination is a switch (see any of the switching devices, see figure 2).

Regarding claim 26, *KAGEMOTO* discloses wherein the operation is a relay switch operation (see col. 10 lines 65 to col. 11 line 30).

Regarding claim 27, *KAGEMOTO* discloses the detection section determines that a relay switch operation is being performed if the detection section determines that the incoming cell is received from a switch (see col. 10 line 65 to col. 11 line 30)

Regarding claim 28, *KAGEMOTO* discloses the assembler section associates a destination address with the produced cell (see col. 10 line 65 to col. 11 line 30).

Regarding claim 29, *KAGEMOTO* discloses the assembler section changes the destination address of the produced cell if the operation is being performed (see col. 10 line 65 to col. 11 line 30).

Regarding claim 30, *KAGEMOTO* discloses the network device is a voice relaying device (see col. 10 lines 65 to col. 11 line 30).

Regarding claim 31, *KAGEMOTO* discloses a network device, comprising:
a receiver section to operate on an incoming cell to produce a first signaling cell and a first voice cell (the demultiplexer 31 receives the incoming cells, see figure 1);
a cell assembly/disassembly unit to operate on the first voice cell to produce a second voice cell and to operate on the first signaling cell to produce a second signaling cell (the demultiplexer 31 demultiplex the received cells and the multiplexer 39 multiplex the cells, see figure 1); and
a transmitter section to make an outgoing cell available to a network, where the outgoing cell comprises the second voice cell and the second signaling cell (see figures 1 and 2).

Regarding claim 35, *KAGEMOTO* discloses the outgoing cell is made available to switch (the output of multiplex 39, see figures 1 and 2).

Regarding claims 36 and 45, *KAGEMOTO* discloses a method, comprising:
demultiplexing a received cell into a first voice cell and a first signaling cell;
disassembling the first voice cell into a first voice signal (the demultiplexer 31 receives the incoming cells and demultiplexes the signals, see figure 1) ;
adding an identification signal to the first voice signal to produce a second voice signal (the multiplexer 39 multiplex the signals, see figure 1); and
making the second voice signal available to a network (transmitting the second ATM cell back the ATM network, see figure 1).

Regarding claim 37, *KAGEMOTO* discloses producing a new cell that includes a second signaling cell having the first signaling cell associated therewith and a second voice cell having the second voice signal associated therewith; and sending the new cell to a destination (see col. 10 lines 65 to col. 11 line 30).

Regarding claim 38, *KAGEMOTO* discloses detecting that a relay switch operation is being performed if the second voice signal is received from a destination (see col. 10 line 65 to col. 11 line 30).

Regarding claim 39, *KAGEMOTO* discloses sending the second voice signal to a switch (the output from multiplex 39 routs the cells to it destinations, see figures 1 and 2).

Regarding claim 40, *KAGEMOTO* discloses wherein the adding further comprises: adding a synchronous signal to the first voice signal as the identification signal (see col. 10 line 65 to col. 11 line 30).

Regarding claim 41, *KAGEMOTO* inherently discloses the disassembling the first voice cell further comprises: decoding the first voice signal (see abstract); and producing a pulse code modulated (PCM) voice signal from the decoded first voice signal (producing PCM signal is inherent feature for voice communication over data network).

Regarding claim 42, *KAGEMOTO* discloses receiving a second cell from a destination; demultiplexing the second cell to produce a received voice cell (see abstract; and figure 1); and determining if the received voice cell includes the identification signal (virtual channel identifiers of the plurality of demultiplexed virtual channels transmitting voice signals and the second lines, see col. 3 lines 18-24).

Regarding claim 43, *KAGEMOTO* discloses determining that a relay switch operation is performed if the received voice cell includes the identification signal (see col. 10 lines 65 to col. 11 line 30).

Allowable Subject Matter

Claims 32-34, and 44 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any response to this action should be mailed to:

The following address mail to be delivered by the United States Postal Service (USPS) only:

Mail Stop _____
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bob A. Phunkulh** whose telephone number is **(571) 272-3083**. The examiner can normally be reached on Monday-Tuesday from 8:00 A.M.

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to 5:00 P.M. (first week of the bi-week) and Monday-Friday (for second week of the bi-week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor **Jay Patel**, can be reach on **(571) 272-2988**. The fax phone number for this group is **(571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bob A. Phunkulh
Primary Examiner
TC 2600
Technology Division 2619
February 04, 2008